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EXAMINER

FLEURANTIN, JEAN B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2162 | |

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/720,031

Applicant(s)

SPIVACK ET AL.

Examiner

JEAN B. FLEURANTIN

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This is in response to Applicant(s) arguments submitted on 8/07/06.

The following is the current status of claim(s):

Claim 1 remains pending for examination.

Response to Applicant' Remarks

Applicant's arguments filed 8/07/06 have been fully considered but they are not persuasive for the following reasons, see section I (rejection maintained and repeated below) and section II (response to argument).

Claim Rejections - 35 USC § 101

- I. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 1,

As set forth in MPEP 2106:

Products may be either machines, manufactures, or compositions of matter.

A *machine* is "a concrete thing, consisting of parts or of certain devices and combinations of devices." *Burr v. Duryee*, 68 U.S. (1 Wall) 531, 570 (1863).

Claim 1, in view of the above cited MPEP section is not statutory, because "storing specific data of a request in the request semantic object and specific data of an offer in the offer semantic object; wherein each semantic object is routed in a network and contains policies that determine how each semantic object should be matched" the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of

steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,513,059 issued to Gupta et al., ("Gupta") in view of U.S. Patent No. 5,809,297 issued to Kroenke et al., ("Kroenke").

As per claim 1, Gupta discloses "a method of matching an offer semantic object" (i.e., similarities between objects; see col. 6, lines 49-51) and "a request semantic object" (i.e., sends (request)

performatives using semantic messaging (semantic object); see col. 13, lines 29-30), the method comprising:

“a request semantic object by completing semantic object templates” (i.e., specifying message topics using templates, in which a template object compares each message posted with topics specifying in the template; see col. 11, lines 36-38); and

“storing specific data” (i.e., encapsulating logic (specific data); see col. 9, lines 23-25) “of a request in the request semantic object” (i.e., sending (request) performatives to node using semantic messaging (semantic object); see col. 13, lines 29-30) and “specific data of an offer in the offer semantic object” (i.e. performatives semantic messaging; see col. 13, lines 29-32);

“wherein each semantic object is routed in a network” (i.e., semantic message to be routed to a particular node; see col. 13, lines 17-18 and col. 9, lines 25-29) “contains policies that determine how each semantic object should be matched” (i.e., all node replicas are required to support the same subset of policies; see col. 8, lines 2-10). Gupta fails to explicitly disclose creating an offer semantic object. However, Kroenke disclose creating an offer semantic object (see Kroenke col. 5, lines 29-30).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Kroenke with creating an offer semantic object as disclosed by Kroenke (see Kroenke col. 12, lines 15-20 and Fig. 1). Such a modification would allow the teachings of Gupta to provide a user to create semantic object data models that represent any kind of information that the user desires to store in a database (see Kroenke col. 5, lines 26-29), thereby improving the accuracy of the methods and systems for managing offers and requests in a network.

II. The Replacement Sheets of Drawings Figures 8 and 23, submitted on 8/07/06, have been entered and considered.

The Office action sated, “the drawings 2-6, 9-22, 24-29 and 31are objected to under 37 CFR 1.83(a) because they fail to show the features page 14, line 11 to page 64, line 9 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention

should be shown in the drawing. MPEP § 608.02(d)." Thus, the objection is proper because, e.g. reference numeral 2 is used to refer to slots and data references and reference numeral 3 is used to refer to tags (page 15, line 6) and references (page 15, line 19). Applicant's disclosure makes references in the specification to corresponding features in the drawings. However, the same numbers in the drawings (e.g. numerals 2 & 3) are used for different features in the specification. Please note that these are merely exemplary. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification and the drawings.

In response to applicant's argument, page 7, line 4 to page 8, that "neither Gupta nor Kreoke, alone or in combination, anticipates or renders obvious a methods in which offer and request semantic objects are created," the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Gupta fails to explicitly disclose creating an offer semantic object. However, Kroenke disclose creating an offer semantic object (see Kroenke col. 5, lines 29-30). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Kroenke with creating an offer semantic object as disclosed by Kroenke (see Kroenke col. 12, lines 15-20 and Fig. 1). Such a modification would allow the teachings of Gupta to provide a user to create semantic object data models that represent any kind of information that the user desires to store in a database (see Kroenke col. 5, lines 26-29), therefore, improving the accuracy of the methods and systems for managing offers and requests in a network.

In response to applicant's argument, page 7, lines 18-19, Gupta does not teach that templates be used in creating offer and request semantic objects." It is noted that the template object compares each message posted in response to identified topics of concern, which logically defines offer and object

request; the client specifying message topics using templates; see Gupta col. 13, lines 29-30. The Examiner has broadly interprets the claimed "template" in the rejection, thus, complying with MPEP 2111.

In response to applicant's argument, page 7, lines 20-22, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., creation of offer and request semantic objects, providing them with specific data, wherein the objects are routed in a network and contain policies regarding matching) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims; the claim does not recite "providing semantic objects with specific data" in relation with the request. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Gupta discloses template object comparing each message posted in response to identified topics of concern, which logically defines offer and object request and the client specifying message topics using templates.

In response to applicant's argument, page 10, lines 3-9, that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Thus, It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Kroenke with creating an offer semantic object as disclosed by Kroenke (see Kroenke col. 12, lines 15-20 and Fig. 1). Such a modification would allow the teachings of Gupta to provide a user to create semantic object data models that represent any kind of information that the user desires to store in a database (see Kroenke col. 5, lines 26-29), therefore, improving the accuracy of the methods and systems for managing offers and requests in a network.

MPEP 2111: During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" Applicant always has the opportunity to amend

the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim. See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in application's specification.").

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). For the above reasons, it is believed that the last Office Action was proper.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

CONTACT INFORMATION

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEAN B. FLEURANTIN whose telephone number is 571 – 272-4035. The examiner can normally be reached on 7:05 to 4:35.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571 – 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

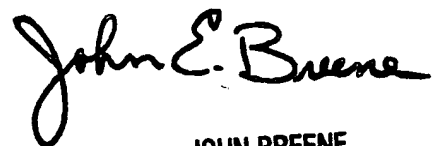


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Patent Examiner

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October 11, 2006



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